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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: FORD, GARRETT N.

DOCKET NO.: 122142.00009

SERIAL NO.: 10/755,984

FILED: 01/13/2004

EXAMINER: NGUYEN, SON T.

ART UNIT: 3643

TITLE: HORSE BOOT WITH DUAL TONGUE ENTRY

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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CERTIFICATE OF MAILING

I hereby certify that on this 26th day of October, 2005, this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Kathleen C. Tennant
Kathleen C. Tennant

TRANSMITTAL OF BRIEF ON APPEAL

Dear Sir:

Pursuant to the provisions of 37 C.F.R. 1.192, the appellant is hereby submitting three (3) copies of a Brief on Appeal in the above-captioned patent application.

Please charge the \$250.00 appeal brief filing fee required by 37 C.F.R. 1.17(c), and any other cost or credit any overpayment associated with the filing of this Brief on Appeal, to our Deposit Account No. 17-0055.

Respectfully submitted,

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TO THE COMMISSIONER FOR PATENTS

BRIEF ON APPEAL

Dear Sir:

This is an appeal from the final rejection dated 10 June 2005.

10/31/2005 WASFAW1 00000015 170055 10755984

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REAL PARTY IN INTEREST

The real party in interest is EasyCare, Inc., the assignee of the entire interest in the above-identified application.

RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are currently pending.

STATUS OF CLAIMS

Claims 1-19 were originally filed. These included the independent claim 1 and its dependent claims 2-17 as well as the independent claim 18 and its dependent claim 19.

Claims 1, 3-6, 11, 13, 15 and 17-19 have been amended. Furthermore, claim 20 was added to depend from claim 18 and claim 21 was added to depend from claim 1.

Claims 1-21 are on appeal.

STATUS OF AMENDMENTS

No amendment was filed subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is an independent claim directed to an article of footwear 10 for a hoofed animal (page 6, lines 2-4). The article of footwear 10 comprises a support 12 designed to bear against a hoof of the animal and against the ground (page 6, lines 5-8). The article of footwear 10 further comprises an enclosure 14 designed to enclose at least part of the hoof of the animal, and the enclosure 14 includes a wall 16,18 on the support 12 (page 6, line 9 to page 7, line 4). The enclosure 14 additionally includes a pair of tongues 24,32 each of which is of one piece with the support 12 and each of which has a major portion which is pivotable relative to the wall 16,18 (page 7, lines 11-14 and page 8, lines 10-14).

Claim 18 is a second independent claim directed to an article of footwear 10 for a hoofed animal (page 6, lines 2-4). The article of footwear 10 comprises a support 12 designed to bear against a hoof of the animal and against the ground (page 6, lines 5-8). The article of footwear 10 further comprises an enclosure 14 designed to enclose at least part of the hoof of the animal, and the enclosure 14 includes a wall 16,18 on the support 12 (page 6, line 9 to page 7, line 4). The enclosure 14 additionally comprises a tongue 32 on the support 12 movable relative to the wall 16,18 and at least one band 36a,36b of elastic material connected to the tongue 32 and to the wall 16,18 (page 8, lines 10-12 and page 8, line 18 to page 9, line 2).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. A first ground of rejection is that of claims 1, 2, 4, 5, 7-10, 12 and 14-21 under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,174,754 to Glass.
- B. A second ground of rejection is that of claims 1-6, 10 and 18-21 under 35 USC 102(b) as being anticipated by U.S. Patent No. 2,986,823 to Kos.
- C. A third ground of rejection is that of claims 11 and 13 under 35 USC 103(a) over Glass in view of U.S. Patent No. 6,202,953 to Hammerslag.

ARGUMENT

For convenience, the appellant has attached as Exhibit A a copy of the drawings filed in the above-identified application. The drawings consist of Figures 1-8.

Also for convenience, the appellant has attached as Exhibit B copies of the references relied upon by the PTO in the final rejection of the claims.

Before addressing the rejections of the claims in detail, the appellant would respectfully like to draw the Board's attention to a few brief comments.

It is well-established that the PTO is entitled to interpret the terms of a claim as broadly as possible. However, the interpretation given to a term of a claim must nevertheless conform to common usage of the English language taking into account, among other things, the context in which the term is employed.

From the outset, the appellant used the term "tongue" in the claims, as opposed to a broader term such as "flap", for example, because a "tongue" in an article of footwear has an unambiguous meaning not only to those skilled in the art but to everyone else as well. Thus, a tongue in an article of footwear is an element having the following characteristics among others: (a) a flap-like appearance; and (b) an ability to pivot away from the space which accommodates a foot, hoof or like anatomical part so as to facilitate entry of the foot, hoof or like anatomical part into the article of footwear.

The appellant will now address the rejections of the claims.

A. Rejection of claims 1, 2, 4, 5, 7-10, 12 and 14-21 under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,174,754 to Glass

Glass discloses a horse boot having an unnumbered sole or support designed to bear against a hoof of a horse and against the ground. The sole carries an enclosure designed to enclose at least part of the hoof, and the enclosure includes a wall 13 as well as an unnumbered tongue. A fold 51 on either side of the tongue joins the tongue to the wall 13.

A constriction mechanism for tightening the horse boot of Glass around the hoof of the horse includes a pair of side plates 26 secured to the inner surface of the wall 13 on opposite sides of the unnumbered tongue. The constriction mechanism further includes a serrated strap 28 which is likewise secured to the inner surface of the wall 13 and runs around the rear of the boot from one of the side plates 26 to the other. A rivet 46 is mounted on each side plate 26 and supports a slide shoe 44 in the form of a rotatable sheave.

The constriction mechanism additionally includes a cable 19 having two ends which are anchored to the unnumbered tongue by a bracket 45. The cable 19 extends from the bracket 45 to the two folds 51 on the opposite sides of the tongue and passes through apertures 50 in the folds 51 to the sheaves 44. The cable 19 passes over the sheaves 44, through apertures 54 in the folds 51 and to an overcenter buckle 27' which can tension the cable 19 so as to tighten the boot around the hoof of the horse.

In rejecting claim 1 and its dependent claims over Glass, the PTO takes the position that each of the flaps 51 of Glass is a tongue. However, in interpreting the flaps 51 as tongues, the PTO has gone beyond a broad interpretation of claim language into setting its own definitions. It appears evident that the folds 51 of Glass do not fit the generally accepted view of a tongue in an article of footwear. As noted above, one characteristic of such a tongue is the ability to pivot away from the space which receives a foot, hoof or like

anatomical part, and the folds 51 of Glass do not possess this ability. Thus, in contrast to claim 1 and its dependent claims which specify a pair of tongues 24,32, the horse boot of Glass has only one tongue, namely, the unnumbered tongue located between the folds 51. It follows that claim 1 and its dependent claims are not anticipated by Glass.

Re: claims 4, 5, 18 and 19

These claims recite at least one band 36a,36b of elastic material connected to a tongue 32 and to the wall 16,18 forming part of the enclosure 14 for the hoof of the animal. The PTO considers the cable 19 of Glass to be such a band of elastic material.

To begin with, Glass fails to mention any material for the cable 19. Accordingly, it would appear that the PTO has improperly assumed an elastic nature for the cable 19 based on the appellant's disclosure. Moreover, since the cable 19 must be tensioned in order to tighten the horse boot of Glass around the hoof of a horse, the appellant believes that the cable 19 cannot be elastic. If the cable 19 were elastic, the cable 19 would stretch as one attempted to tighten the horse boot of Glass and it would be extremely difficult, if not impossible, to tension the cable 19 sufficiently for adequate tightening of the boot.

The appellant also wishes to point that claims 4, 5, 18 and 19 specify that the band of elastic material is part of the enclosure for the hoof of the animal. On the other hand, the

cable 19 of Glass does not form part of the Glass enclosure but constitutes part of a tightening means for the enclosure.

With specific reference to claims 5 and 19, it is noted that these specify an additional band of elastic material. The PTO takes the position that the cable 19 of Glass comprises a right-hand portion and a left-hand portion and that each of these portions constitutes a band of elastic material. However, inasmuch as the cable 19 of Glass is of one piece, it is not seen that the right-hand portion of the cable 19 can be considered a first band of elastic material while the left-hand portion is considered an additional band of elastic material.

Re: claims 7-9

Claims 7-9 set forth a protrusion 40 on a tongue 32 to facilitate manipulation of the tongue 32. The PTO states that Glass teaches a protrusion 19 on one of the tongues 51 since the cable 19 will lie on or against the tongues when the cable 19 is pulled tight.

According to claims 7-9, the protrusion is provided to facilitate manipulation of the tongue. Even if the cable 19 could be construed as a protrusion on the tongues when pulled tight, the cable 19 would not be able to facilitate manipulation of the tongues.

Re: claim 14

Claim 14 is directed to a means 42 for tightening the enclosure 14 for the hoof of the animal around the leg of the animal. The tightening means 42 comprises a tightening element 44 which engages the enclosure 14 and an operating device 46 designed to exert a force on the tightening element 44 so as to draw the enclosure 14 around the leg of the animal. In accordance with claim 14, the operating device 46 includes a rotary mechanism.

The PTO is of the opinion that the operating device 27' or 49 of Glass constitutes a rotary mechanism. However, the appellant believes that a rotary mechanism is generally accepted to be one which turns in the manner of a wheel as opposed to the mechanism 27' or 49 of Glass which pivots.

B. Rejection of claims 1-6, 10 and 18-21 under 35 USC 102(b) as being anticipated by U.S. Patent No. 2,986,823 to Kos

Kos discloses an overshoe for women which, as shown in Fig. 6, is made from a sheet of material 10. The sheet 10 includes a vamp section 11, a heel section 12 and a sole section 13 and is provided with pleats. Each of the pleats comprises a relatively straight edge portion 16 and a notched portion 15, and the sheet 10 is formed into an overshoe by sewing an elastic thread 17 through the edge portions 16. As illustrated in Figs. 2 and 4 of Kos, an

elastic strap 20 and a button 21 are respectively attached to the overshoe 10 at points c and d on the vamp section 11. The overshoe 10 is designed for use on shoes of different size.

In rejecting claim 1-6, 10 and 18-21 over Kos, the PTO states that the overshoe 10 of the reference "is capable of being used on a hoofed animal". Moreover, in response to previous arguments by the appellant, the PTO additionally states that the recitation "for a hoofed animal" (found in the preambles of claims 1 and 18) is intended use or functional language which is not given weight.

To begin with, the appellant wishes to point out that the recitation "for a hoofed animal" is not simply an intended use or functional language. Thus, this recitation provides antecedent basis for the term "hoof" in the bodies of claims 1 and 18.

Furthermore, while the PTO states that the overshoe 10 of Kos "is capable of being used on a hoofed animal", the claims specify a support designed to bear against a hoof of an animal and an enclosure designed to enclose at least part of the hoof of the animal. As stated in column 2, lines 7-11 of Kos, "...there is provided a sheet of flexible, light weight plastic material 10..." (emphasis by the appellant). It seems evident that such a sheet of material is not designed to bear against a hoof of an animal. The appellant also believes it to be clear that the enclosure defined by the overshoe of Kos is not designed to enclose at least part of the hoof of an animal. Rather, it is designed to fit snugly over a woman's shoe.

The appellant additionally notes that the claims recite an article of footwear with at least one tongue. Although the PTO states that the overshoe of Kos has an enclosure 10 with tongues in the form of front and back flaps at reference characters 22,23,12,a and 20,34,35, it appears obvious that the overshoe of Kos does not have a tongue as the term is commonly applied to an article of footwear. As noted earlier, one characteristic of a tongue in an article of footwear is a flap-like appearance which, contrary to the PTO's assignment of the term "front and back flaps" to the pleats at reference characters 22,23,12,a and 20,34,35 of Kos, is not the case for such pleats. The PTO has here again gone away from generally accepted terminology since nobody outside of the PTO would consider the tongue-less overshoe of Kos as having a tongue.

The appellant's assertion that the overshoe of Kos lacks a tongue is also borne out by the disclosure of the reference. While Kos describes the overshoe as having a vamp section 11, a back or heel section 12 and a sole section 13 (column 2, lines 7-15 of Kos), no mention is made of a tongue section. It follows that no tongue is present in the overshoe of the reference.

The appellant thus believes that claims 1-6, 10 and 18-21 are not anticipated by Kos.

C. Rejection of claims 11 and 13 under 35 USC 103(a) over U.S. Patent No. 4,174,754 to Glass in view of U.S. Patent No. 6,202,953 to Hammerslag

Hammerslag discloses a sport boot 20, such as an ice skating boot, having a lace 23 and a tightening mechanism 25 for the lace 23. The tightening mechanism 25 comprises a gear assembly 70 accommodated in a housing 60 and a knob 62 on the exterior of the housing 60 for tensioning the lace 23. The housing 60 is constituted by two interlocking parts 64a and 64b held together by screws 66.

Claims 11 and 13 set forth a means for tightening the article of footwear around the leg of an animal, and these claims also specify a removable cover for at least part of the tightening means. Hammerslag is applied to teach a removable cover for a tightening means, and the PTO considers the gear assembly 70 of Hammerslag to constitute a tightening means. The PTO further considers the housing 60 of Hammerslag to constitute a removable cover for the gear assembly 70 since the housing 60 can be opened by removing the screws 66 which hold together the interlocking parts 64a,64b of the housing 60.

The appellant believes that, in the absence of the appellant's disclosure, one of ordinary skill in the art dealing with the horse boot of Glass would: (i) see no reason to consider the sport boot of Hammerslag; and (ii) lack any motive to apply the teachings of Hammerslag to Glass, i.e., what benefit is obtained from applying the teachings of Hammerslag to

Glass? Accordingly, it is the appellant's opinion that claims 11 and 13 are not obvious from Glass in view of Hammerslag.

In view of the foregoing, it is respectfully submitted that the rejections of the claims should be reversed in their entirety.

Respectfully submitted,



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CLAIMS APPENDIX

1. An article of footwear for a hoofed animal comprising:
 - a support designed to bear against a hoof of the animal and against the ground; and
 - an enclosure designed to enclose at least part of the hoof of the animal, said enclosure including a wall on said support, and said enclosure further including a pair of tongues each of which is of one piece with said support and each of which has a major portion which is pivotable relative to said wall.
2. The article of claim 1, wherein said tongues are located diametrically opposite one another.
3. The article of claim 1, wherein said enclosure further comprises at least one band of pleated material connected to one of said tongues and to said wall.
4. The article of claim 1, wherein said enclosure further comprises at least one band of elastic material connected to one of said tongues and to said wall.
5. The article of claim 4, wherein said one tongue has a pair of opposed edges and said one band joins one of said edges to said wall, said enclosure including an additional band of elastic material joining the other of said edges to said wall.

6. The article of claim 4, wherein said enclosure further comprises at least one band of pleated material connected to the other of said tongues and to said wall.
21. The article of claim 4, wherein said one tongue and said at least one band are made from different pieces of material.

7. The article of claim 1, further comprising a protrusion on one of said tongues to facilitate manipulation of said one tongue.
8. The article of claim 7, wherein said protrusion comprises a strap.
9. The article of claim 7, wherein said protrusion defines a loop.
10. The article of claim 1, further comprising means for tightening said enclosure around the leg of the animal.
11. The article of claim 10, further comprising a removable cover for at least part of said tightening means..
12. The article of claim 10, wherein said tightening means comprises a tightening element which engages said enclosure and an operating device designed to exert a force on said tightening element so as to draw said enclosure around the leg of the animal.

13. The article of claim 12, further comprising a removable cover for at least part of said operating device.

14. The article of claim 12, wherein said operating device comprises a rotary mechanism.

15. The article of claim 12, wherein said operating device is mounted on said wall.

16. The article of claim 12, wherein said operating device is mounted on one of said tongues.

17. The article of claim 12, wherein said tightening element passes through said wall and is slidable relative thereto.

18. An article of footwear for a hoofed animal comprising:

a support designed to bear against a hoof of the animal and against the ground; and

an enclosure designed to enclose at least part of the hoof of the animal, said enclosure including a wall on said support, a tongue on said support movable relative to said wall, and at least one band of elastic material connected to said tongue and to said wall.

19. The article of claim 18, wherein said tongue has a pair of opposed edges and said one band joins one of said edges to said wall, said enclosure including an additional band of elastic material joining the other of said edges to said wall.

20. The article of claim 18, wherein said tongue and said at least one band are made from different pieces of material.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Not applicable.

EXHIBIT A

Figures 1-8 of the above-identified application.

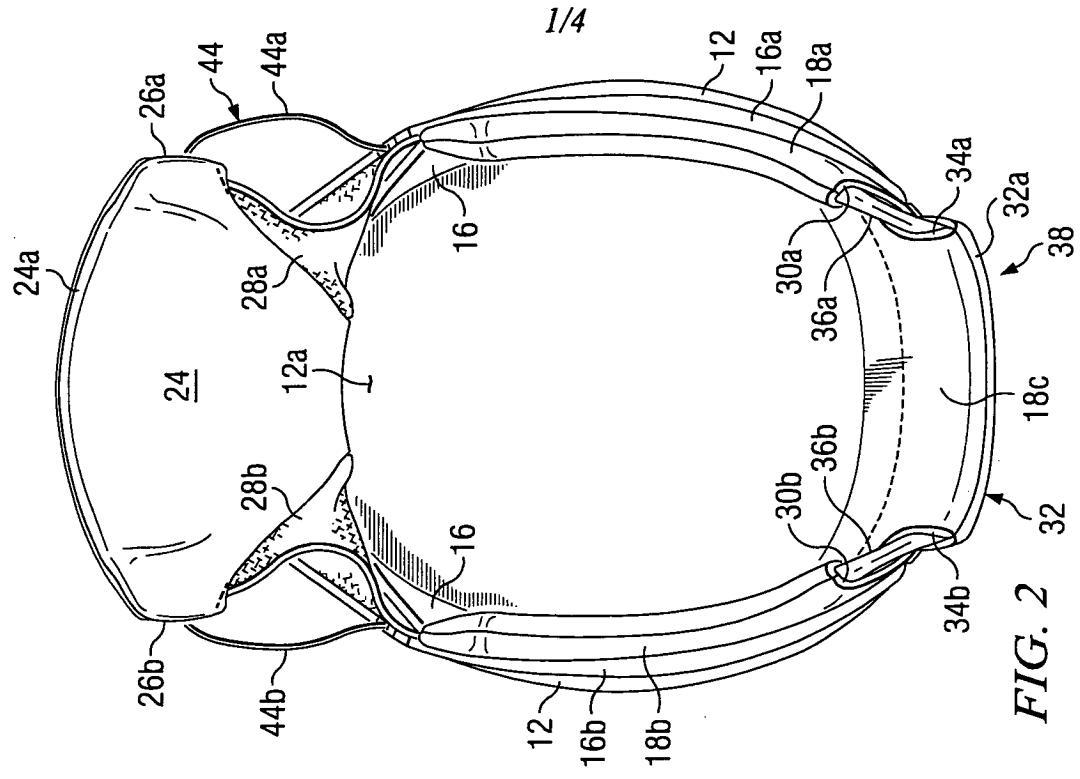


FIG.

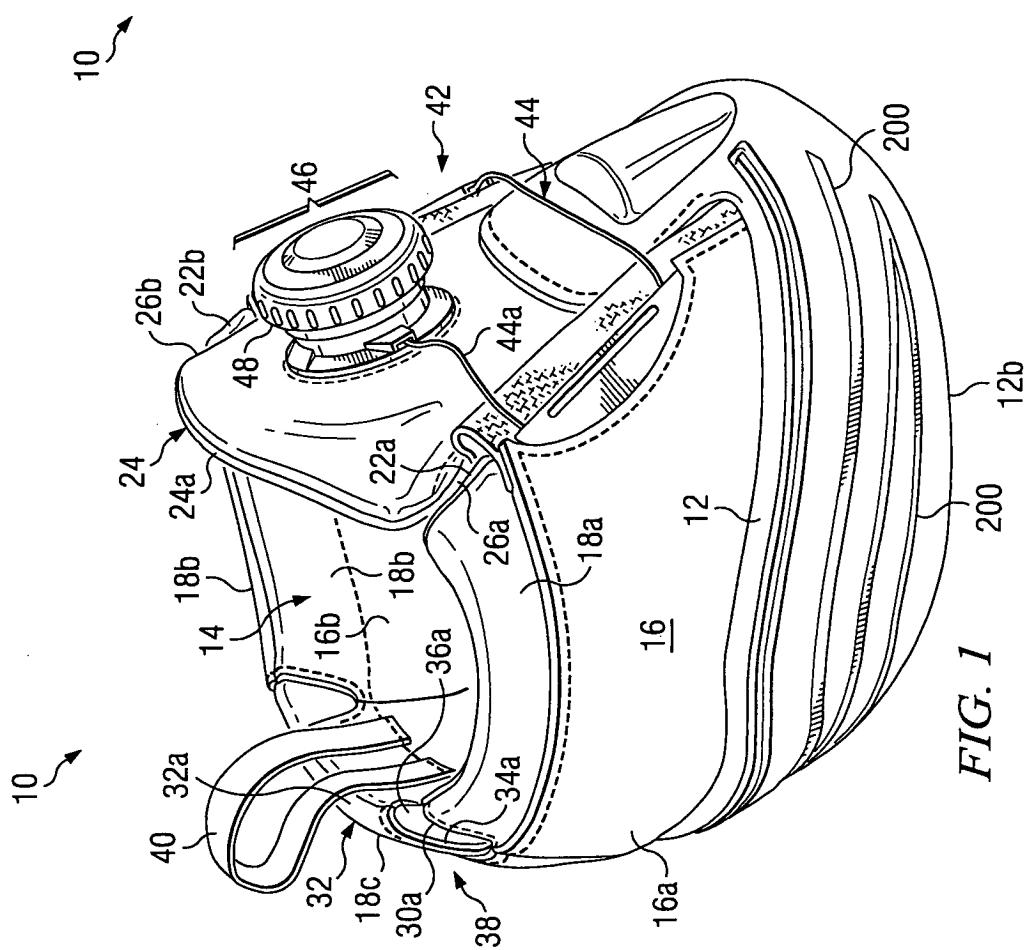


FIG. 1

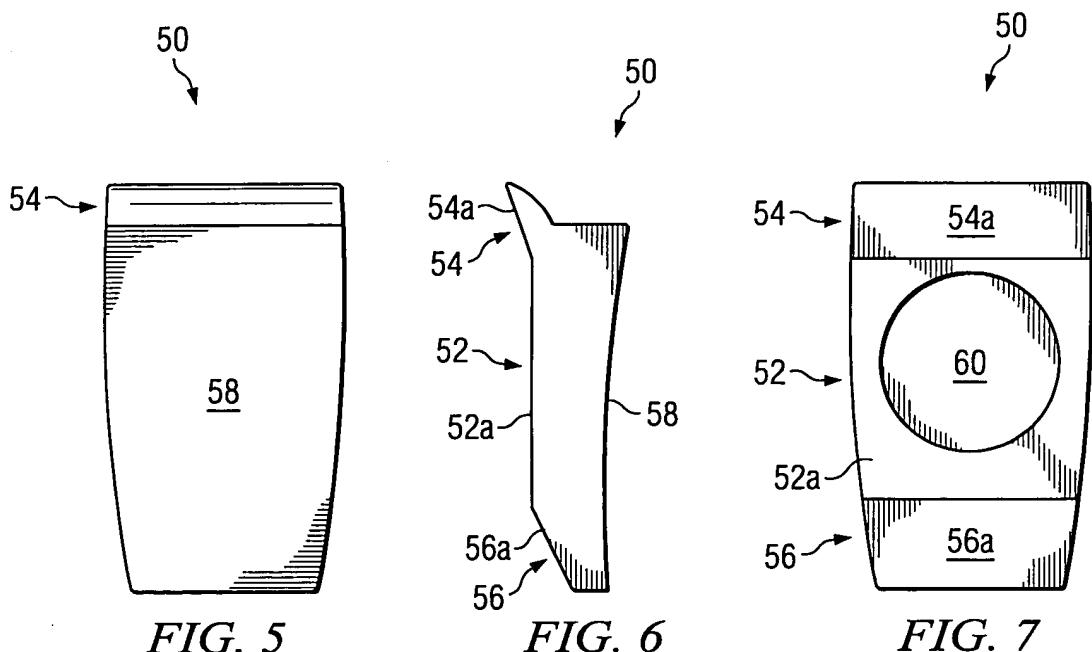
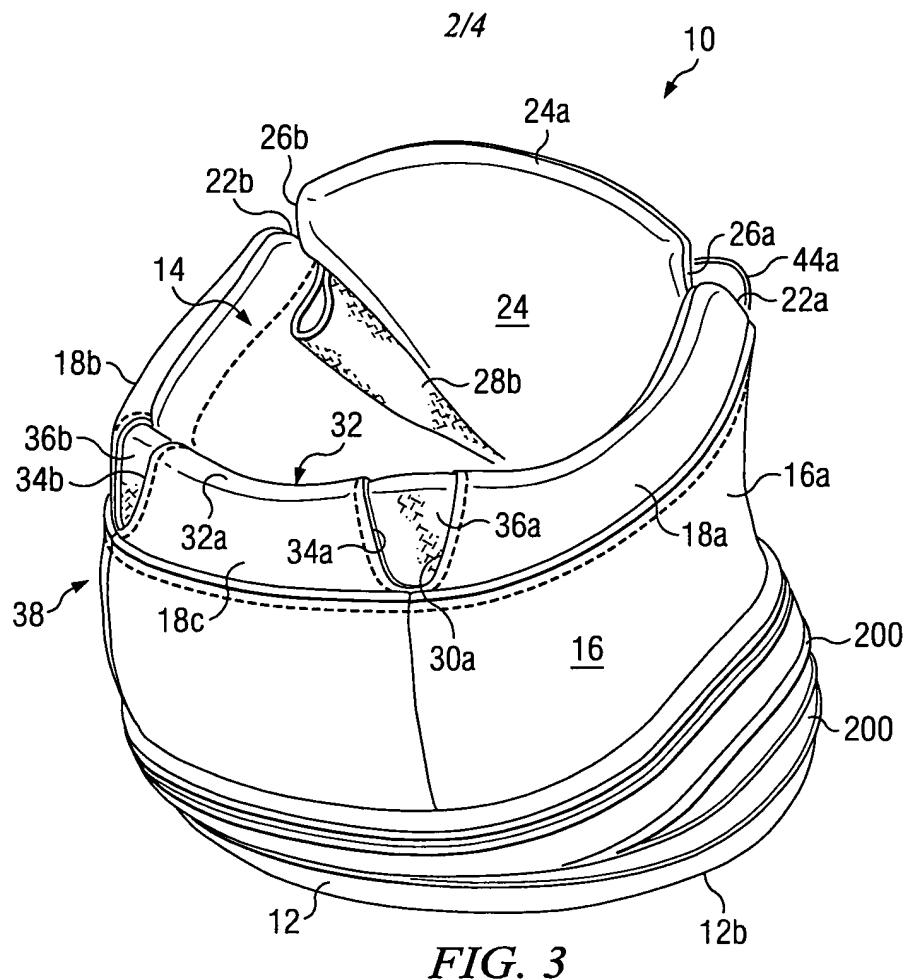
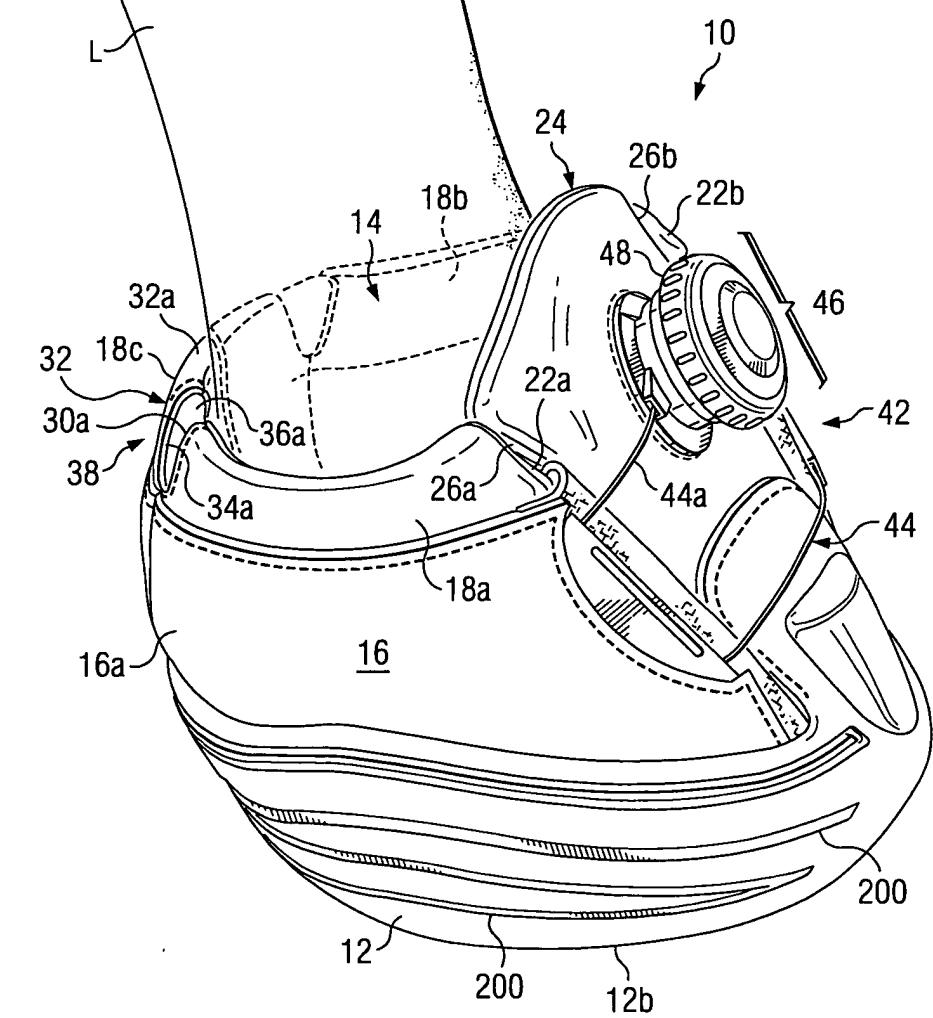


FIG. 4

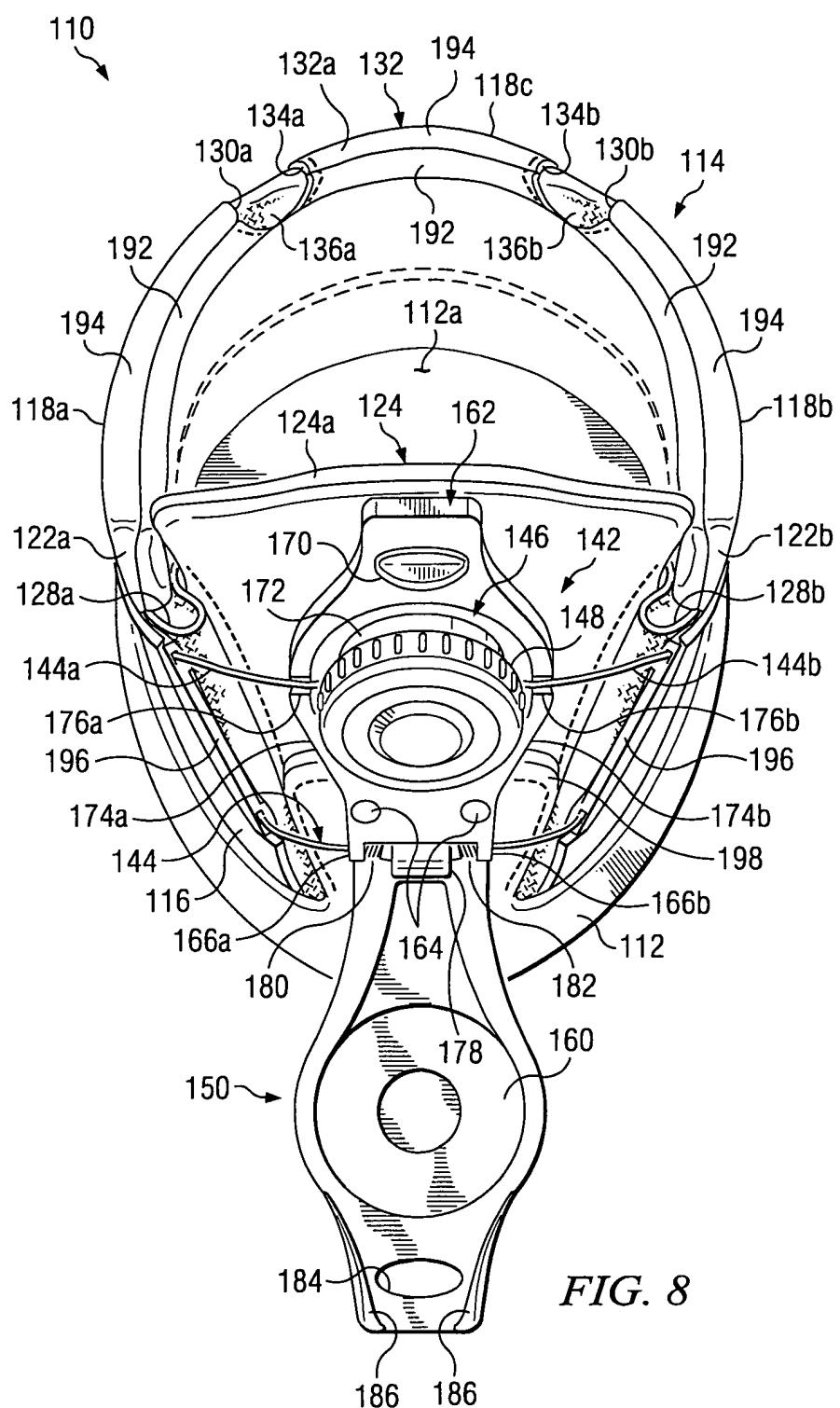


FIG. 8

EXHIBIT B

References relied upon by the PTO in the final rejection of the claims:

1. U.S. Patent No. 4,174,754 to Glass.
2. U.S. Patent No. 2,986,823 to Kos.
3. U.S. Patent No. 6,202,953 to Hammerslag.